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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/491,787	01/26/2000	Andrew T Wilson	INTL-0317-US (P8000)	9051

7590 10/31/2003

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EXAMINER

BOCCIO, VINCENT F

ART UNIT	PAPER NUMBER
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2615

DATE MAILED: 10/31/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

KS

Office Action Summary

Application No.

09/491,787

Applicant(s)

WILSON ET AL.

Examiner

Vincent F. Boccio

Art Unit

2615

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2,3,4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

The Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 2615.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:
A person shall be entitled to a patent unless --
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-2, 7-12, 17-25 are rejected under 35 U.S.C. 102(b) as being anticipated by Mankovitz (WO 98/48566).

Regarding claims 1-2, Mankovitz discloses and meets the limitations associated with a method and apparatus comprising:

- o receiving video (Fig. 1, "tuner") and enhanced content (PRI) information (Fig. 4, "TV and PRI");

- o storing the video information for subsequent playback in a random access memory (page 4, "digital video device storage 52", "disk, magnetic, optical, solid state, RAM etc.");

- o storing the enhanced content information in a RAM (page 5, lines 15-30, "PRI .. in the VBI" to "VBI decoder website data memory 36", also see page 8, lines 27-, "The television signal including the embedded website addresses is stored on the storage device 52 and hence the corresponding WEB pages remain linked to the appropriate portion of the television program as the signal

is read out from the storage .. "), further col. 9, lines 9-,
"The storage device continuously stores the television signal ..
whenever the system is operational ... ", "allows the viewer to
interrupt .. viewing .. to interact with PRI carried in the
VBI").

Claims 11-12, analyzed and discussed with respect to the
claims above applied to Mankovitz, wherein claims 11- further
recite the limitation of an article of manufacture met by
Mankovitz (Fig. 1) by providing instructions on a medium (page 5,
line 36, "Microprocessor 24 is programmed to carry out this
operation", therefore, processor based control thru
microprocessor 24), that cause a processor (24), based system to:
perform the steps as recited.

Regarding claims 7-10 and 17-20, Mankovitz meets the
limitations of deriving, "a key frame or a software key frame",
from the enhanced content information (see Fig. 4, "PRI");

wherein upon selecting the key frame or the PRI, the
enhanced content is retrieved and presented to the user,
therefore obtained and replayed by presenting the content to the
user on the display,

further the video and enhanced content can be stored first,
thereafter replayed from storage 52 wherein the Web pages
representing the enhanced content or Web pages remain linked to
the appropriate portion of the video or TV program, for the use

to interact with to replay the Web page information with the video, as shown in Fig. 3 for example video and other enhancement information obtained from a WEB page or cite (page 8, lines 26-35 etc...).

The contents can be stored in a WEB browser buffer (Fig. 1, "WEBSITE Data Memory 36");

wherein the deriving a key frame includes storing a pointer to the stored enhanced content (page 2, lines 19-, "address for an Internet cite including PRI" or the memory "WEBSITE Memory 36", met by the PRI linked to the WEB site address).

Claims 21-25 are analyzed and discussed with respect to the claims above.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 3, 13 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mankovitz (WO 98/48566).

Regarding claims 3, 13 and 26, Mankovitz discloses at page 8, lines 28-35, that storage device 52 can store the video including the enhanced content (website addresses), in storage 52, further at page 4, a variety of storage devices, including a disk, optical, magno-optical, solid state, RAM etc....., type recording devices, but fails to particularly anticipate the recited hard disk drive.

The examiner takes official notice that hard disk drives are well known and obvious viable type of storage, therefore, it would have been obvious to those skilled in the art, at the time of the invention to utilize a HARD DISK drive storage device, being considered to be an obvious design choice to one skilled in the art to utilize the hard disk drive being viable and commercially available type of storage device, as would have been obvious to those skilled in the art at the time of the invention.

5. Claims 4-6 and 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mankovitz (WO 98/48566) as applied above in view of Blacketter et al. (US 6,415,438).

Regarding claims 4-6 and 14-16, Mankovitz discloses wherein some of the PRIs can be time dependent on the program, possible recording the PRI web sites with the video to be decoded from the VBI on playback having a time associated with the video and further to receive digital TV signals in the system such as HDTV

(col. 11),

but, fails to disclose having a time code to synchronize the video with the enhanced content, claim 4; and

fails to disclose separate packets for video including time code, as claimed in claim 5; and

providing a packet including video and enhanced content information, as claimed in claim 6.

Blackketter teaches providing enhance content by providing a trigger with a time code information (col. 4, lines 57-62), "to synchronize the video with the enhanced content",

which the receiver determines the future time from the time attribute and waits until the indicated future time with respect to the wall clock date and time (col. 5) or

(utilizes "a media time base", col. 6, lines 5-7, wherein the media time base may be SMPTE time code being the media time base, col. 6, lines 23-39), upon the time and then executes the trigger based on the time attribute, wherein the format of the trigger to the receiving unit are set forth in "EIA-746A, and ATVEF incorporated by reference, wherein the trigger causes an ICON to be displayed wherein the user can select the ICON representing the enhanced content to access the enhanced content by displaying on the receiver unit, col. 8, lines 50-, as taught by Blackketter.

Therefore, it would have been obvious to one skilled in the

art at the time of the invention to modify Mankovitz by incorporating time code information to trigger the presentation of the selection of the enhanced content thru an ICON, to a user for selection to obtain additional information, as taught by Blackketter.

The combination as applied fails to address wherein video is provided in a packetized format, including time code, as recited in claim 5.

The examiner takes official notice that providing video in a packetized format having time code data is well known in the art, which reads directly on an MPEG packetized video stream, therefore, it would have been obvious to one skilled in the art at the time of the invention to modify the combination as applied and provide digital packetized video with enhancements to a tuner, in accord to the MPEG standard for example, as is well known in the art.

Regarding claim 6, the combination as applied renders obvious to receive a packet (MPEG encoded data), wherein the packetized video can comprise enhanced content (Mankovitz, col. 11, lines 4-34, "Digital TV" or "HDTV").

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Contact Fax Information

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703) 872-9314, (for formal communication intended for entry)

or:

(703) 308-5359, (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).


Contact Information

6. Any inquiry concerning this communication or earlier communications should be directed to the examiner of record, Monday-Thursday, 8:00 AM to 5:00 PM Vincent F. Boccio (703) 306-3022.

If any attempts to reach the examiner by telephone are unsuccessful, the examiners supervisor, Andy Christensen (703) 308-9644.

Any inquiry of a general nature or relating to the status of this application should be directed to Customer Service (703) 306-0377.

Primary Examiner, Boccio, Vin
October 27, 2003


VINCENT BOCCIO
PRIMARY EXAMINER